

REMARKS

Claims 1-6 are currently pending in the application. Applicants believe the claims as written are patentably distinguishable over the cited prior art of record, and therefore respectfully decline to amend the claims at this time. Reconsideration and withdrawal of all pending rejections in view of the following remarks is respectfully requested.

35 U.S.C. § 103 Rejection

Claims 1-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 6,671,818 to Mikurak, et al. ("Mikurak"). This rejection is respectfully traversed.

Although the claimed feature of "providing supply and demand curve data, which determines an arrival rate for each customer" is not shown in Mikurak, the Examiner suggests that it would have been obvious for a skilled artisan to modify the teaching of Mikurak to employ any relevant terminology defining a provision of supply (price) and demand data for each known service class of end-users. Applicants first address the fact that the Examiner has not even considered many features of the claimed invention, and thus submit that a prima facie case of obviousness has not been made by the Examiner. Second, Applicants submit that the Examiner's assertion of obviousness is not correct.

In particular, the Examiner has not addressed the following claimed features:

Claim 1:

inputting a mean and variance of real usage for each of a plurality of customer classes; ...

inputting a number of existing customers in each customer class; ...

outputting said amount of bandwidth to be purchased and said expected number of new customers.

Claim 4:

receiving a mean and a variance of real usage for each of a plurality

of customer classes ...

receiving a number of customers in each customer class; ...

outputting said amount of bandwidth to be purchased and said expected number of new customers.

Even if these features were considered, Applicants submit that the Mikurak reference does not even show or suggest such features. For example, Mikurak is directed to providing a system and method for managing assets in a network based supply chain. Mikurak generally discloses monitoring service or product quality on a service class basis to determine:

- i) whether service levels are being met consistently;
- ii) whether any problems with the service or product are being experienced; and
- iii) whether the sale and use of the service is tracking to forecasts.

(Col. 16, lines 14-20).

Mikurak further discloses that a host computer is configured to forecast trends and predict when demand will exceed supply, thus allowing corrective action to be taken. (Col. 23, lines 19-21; Col. 26, lines 21-29).

Even though not addressed by the Examiner, the teachings of Mikurak, if modified, would not suggest or teach the elements recited in claims 1 and 4. For example, Mikurak does not show any relevant terminology defining a provision of supply and demand data for each known service class of customers. Mikurak also does not show or suggest inputting/receiving a mean and variance of real usage for each customer class, inputting/receiving a number of customers in each customer class, or outputting an amount of bandwidth to be purchased together with an expected number of new customers. Mikurak only teaches comparing the supply and demand for manufacturer offerings and using this comparison to plan future supply and demand for the manufacturer offerings. (Col. 23, lines 42-48). Mikurak's disclosure of comparing supply and demand data is different than inputting/receiving a mean and a variance of real usage as claimed. Additionally, the comparison taught by Mikurak does not input a number of customers for each class, and does not output an amount of bandwidth to be purchased together with an

expected number of new customers. Consequently, independent claims 1 and 4 are allowable over Mikurak.

Second, the Examiner admits that Mikurak fails to disclose or suggest "inputting/receiving price and demand curve data, which determines an arrival rate for each customer." It was suggested that unless the specification discloses that this claimed feature provides an advantage over the prior art, one of ordinary skill in the art would have been motivated to modify Mikurak to achieve the claimed feature. Applicants are not aware of any section of the MPEP, or of any case law, that requires the specification to recite an advantage over the prior art for each and every claimed element and that, if such advantage is not shown, such feature would have been obvious in view of the remaining features of the claimed invention.

In the present case, independent claims 1 and 4 are combination claims (e.g., claims comprised of multiple features). Consequently, advantages over the prior art, if any, may be expected to result from the synergy of all the claimed elements. By making this rejection dependent on whether the specification discloses an advantage over the prior art afforded by a single claim element, the Examiner has inadvertently and incorrectly introduced a new requirement for patentability. However, patentability is not determined by whether a single element of a claim affords an advantage over the prior art, or by whether such advantage is recited in the specification. For example, MPEP 2141.02 states:

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103(a) is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.
(Emphasis added)

Although evidence that the invention as a whole provides an advantage over the prior art may be provided to rebut a prima facie case of obviousness, patentability under 103(a) is determined by whether the prior art reference discloses each and every element of the rejected claim(s). Mikurak, however, does not disclose or suggest all of the elements of the claimed invention, nor would it be obvious to modify Mikurak as suggested by the Examiner.

First, no suggestion or motivation to modify Mikurak's teachings is contained in the reference itself. Additionally, the alleged absence of an advantage over the prior art in the specification is not, in itself, a suggestion or motivation for one skilled in the art to modify Mikurak's teachings. Moreover, modification of Mikurak to input/receive a mean and variance of real usage or to input/receive price and demand curve data, which determines an arrival rate for each customer, would most likely render Mikurak's system unsatisfactory for its intended purpose. Mikurak teaches comparing raw supply and demand data to forecast future supply and demand for manufacturer services. Comparing a mean and variance of real usage with price (which may relate to, but is not the same as supply (e.g., quantity) data) and demand curve data, as claimed, would most likely adversely affect the ability to forecast future supply and demand data as taught by Mikurak. Consequently, there is no motivation or suggestion to make the proposed modification.

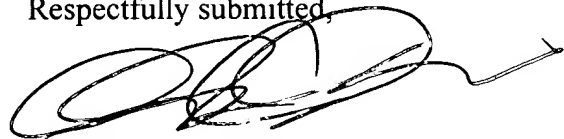
Instead, the Examiner's arguments appear to make sense only if one skilled in the art had read Applicant's specification prior to reading Mikurak. Such arguments, however, are based on hindsight, which is impermissible.

For the reasons set forth above, claims 1 and 4 are allowable over Mikurak, together with their respective dependent claims 2-3 and 5-6. Thus, withdrawal of the rejection of claims 1-6 is respectfully requested.

CONCLUSIONS

In view of the foregoing amendments and remarks, Applicants submit that all of the rejections have been overcome, and that the claims are patentably distinct from the prior art of record and in condition for allowance. The Examiner is respectfully requested to pass the above application to issue, and to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 50-0510 (Yorktown).

Respectfully submitted,



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